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| APPLICATION NO.               | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------|-------------|----------------------|---------------------|------------------|
| 09/856,495                    | 09/24/2001  | Jorg Adler           | P21094              | 2775             |
| 7055                          | 7590        | 08/11/2004           | EXAMINER            |                  |
| GREENBLUM & BERNSTEIN, P.L.C. |             |                      | MENON, KRISHNAN S   |                  |
| 1950 ROLAND CLARKE PLACE      |             |                      | ART UNIT            |                  |
| RESTON, VA 20191              |             |                      | PAPER NUMBER        |                  |

1723

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PS

**Advisory Action**

Application No.

09/856,495

Applicant(s)

ADLER ET AL.

Examiner

Krishnan S Menon

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 19-28,42 and 43.Claim(s) withdrawn from consideration: 29-41,44 and 45.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: attachment

Explanation of how the amended claims would be rejected:

Applicants have not amended any pending claims in the after-final amendment, other than withdrawing the restricted claims 44 and 45.

Therefore, Claims 19-23, 25 – 28, 42 and 43 will be rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over WO/30207 A1; and Claim 24 will be rejected under 35 U.S.C. 103(a) as being unpatentable over WO/30207 A1 in view of Partlow et al (US 5,683,528), as in the final action.

***Response to Arguments***

Examiner apologizes for the inadvertent error in listing of the pending claims in the office action summary of the final action. This would stand corrected as claims 19-45 pending, of which claims 29-41, 44 and 45 withdrawn from consideration.

Applicants' arguments are directed towards the process of making the ceramic multiplayer filter, while claiming the product. However, Applicants have not shown (with evidence) that the process steps recited in the claims would provide discernable structural differences in the product compared to the prior art product and the claims contain no such differences. Arguments regarding the inherency of the 'degree of reduction of pore size' : again, applicants have not provided any evidence that the material in the claimed product would have different structure/characteristics than that of the prior art due to this characteristic of 'degree of reduction of pore size' during process. In any case, this inherent property, degree of reduction of pore size, is also

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part of the process, and does not reflect in the finished product. Also, the claim language reads '... pore volume ... between the ceramic particles is reduced by the material [binder] only slightly ...', which the examiner understands has more to do with filling of the binder between the ceramic particles rather than shrinkage, which is addressed in the final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon  
Patent Examiner

  
W. L. WALKER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700